

### **REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks and accompanying information, which place the application in condition for allowance.

#### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1-16 and 27 are under consideration in this application. Claims 1-16 and 27 have been amended; claim 17 has been cancelled.

The application has been amended to delete references to hyperlinks, overcoming the objection to the specification. The "Sequence protocol", beginning on page 48, line 5, has also been deleted, as it is duplicative of the Sequence Listing that appears after the claims.

Claims 3-7, 9, 10, 12, 13, 15, 16, and 27 have been amended to delete multiple claim dependencies. Claim 27 has also been amended such that it no longer depends on non-elected claims. These amendments overcome the objections to the claims.

Claim 1 has been amended to delete recitations of nucleic acid molecules which constitute derivatives and fragments of the nucleic acid molecules of SEQ ID NOs: 1 and 2. Claim 15 has been amended to clarify that the plant is a wheat plant. The remaining amendments are non-substantive and are made merely to place the claims in better form.

No new matter is added.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. §112. The amendments of and additions to the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled. Furthermore, it is explicitly stated that the herewith amendments should not give rise to any estoppel, as the herewith amendments are not narrowing amendments.

#### **II. THE REJECTIONS UNDER 35 U.S.C. § 112, 2<sup>ND</sup> PARAGRAPH ARE OVERCOME**

Claim 17 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for not setting forth any steps involved in a method or process. Claim 17 has been cancelled, obviating the rejection.

Claim 15 was rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite in its recitation of "relates to". Claim 15 has been amended to clarify that the plant is a wheat plant.

Reconsideration and withdrawal of the rejections under 35 U.S.C. §112, second paragraph, are requested.

**III. THE REJECTION UNDER 35 U.S.C. §101 IS OVERCOME**

Claim 17 was rejected under 35 U.S.C. § 101 as allegedly being an improper process claim. Claim 17 has been cancelled; therefore, reconsideration and withdrawal of this rejection are requested.

**IV. THE REJECTIONS UNDER 35 U.S.C. § 112, 1<sup>ST</sup> PARAGRAPH ARE OVERCOME**

Claims 1-17 and 27 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking adequate written description and enablement. The rejections are traversed and will be treated collectively.

Claim 1 has been amended to delete references to derivatives or fragments of SEQ NO:1 or nucleic acids encoding SEQ ID NO:2. The claims are now limited to plant cells and plants comprising SEQ ID NO:1 or nucleic acid molecules that encode SEQ ID NO:2 and methods for producing transgenic plants and plant cells. The Office Action states on pages 4 and 6 that the specification provides guidance and is enabling for the subject matter that is currently claimed. Therefore, it is submitted that all of the claims under consideration comply with the requirements of 35 U.S.C. §112, first paragraph, and reconsideration and withdrawal of the rejections are requested.

**V. THE REJECTIONS UNDER 35 U.S.C. § 102 ARE OVERCOME**

Claims 1-13, 15-17 and 27 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 97/11188 ("PLANTTEC"). Claims 1-17 and 27 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 99/53072 ("duPont"). These rejections are traversed and will be addressed collectively.

A two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention. *See Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must contain an enabling disclosure. *See Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir.

1990). A reference contains an enabling disclosure if a person of ordinary skill in the art could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself in possession of the invention. *See In re Donohue*, 226, U.S.P.Q. 619, 621 (Fed. Cir. 1985).

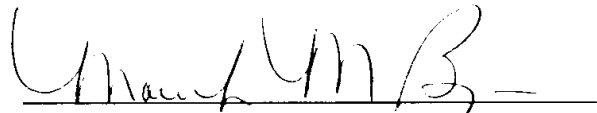
Applying the law to the instant facts, the references relied upon by the Office Action do not disclose, suggest or enable the presently claimed invention. The Office Action alleges that PLANTTEC and duPont teach "derivatives" of SEQ ID NO:1. The amendment to claim 1, removing recitations of "derivatives" and "fragments" renders these rejections moot. PLANTTEC and duPont do not recite the nucleic acid sequence of SEQ ID NO:1, nor do they teach nucleic acid sequences that encode the protein of SEQ ID NO:2. Therefore PLANTTEC and duPont do not anticipate the instant invention, rendering the rejections under 35 U.S.C. § 102(b) moot. Reconsideration and withdrawal of the rejections are requested.

#### CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

By:



Marilyn Matthes Brogan  
Reg. No. 31,223  
(212) 588-0800